

REMARKS

I. Status of the Claims

In the Action dated September 15, 2009, the Examiner states that claim 1 was amended by incorporating non-elected subject matter and has only been considered with respect to the elected subject matter. However, to clarify the record, claim 1 was not amended to incorporate the subject matter of a non-elected invention. The subject matter referred to by the Examiner was deleted from claim 1 and recited in claim 28 in the Amendment filed June 30, 2009.

Claim 1 is amended herein to improve its form.

Claims 24 and 28 are canceled herein, without prejudice or disclaimer. No new matter is presented.

Upon entry of the Amendment, claims 1 and 26-27 will be all of the claims pending in the application. Applicants reserve the right to reintroduce the subject matter of claims 24 and 28 pending a Decision on the Petition for Reconsideration of the Restriction Requirement filed with the Response on June 30, 2009.

II. Petition for Reconsideration

A Decision has not yet been received in response to the Petition for Reconsideration of the Restriction Requirement filed with the Response on June 30, 2009. In the Action at page 4, the Examiner provides comments in response to the request for reconsideration included at page 5 of the Amendment filed on June 30, 2009, however, the Examiner's comments do not replace a Decision on the Petition based on supervisory review as requested. It is noted that the Petition is listed in PAIR as a Supplemental Paper and it is respectfully requested that the Petition should be sent to the appropriate person in the Technology Center for consideration.

III. Response to Claim Rejections under 35 U.S.C. § 103

Claims 1, and 26-27 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Ishikawa et al.

The Examiner states the following on page 4 of the Office Action:

"A composition comprising olanexidine, and an excipient such as a polyoxyethylene higher alkyl ether can not be a special technical feature because it is already known in the prior art. Ishikawa teaches a composition of olanexidine with a polyoxyethylene-based nonionic phenyl ether (see Columns 23 and 24; Prescriptions 1 and 2). As such the Ishikawa reference makes the combinations of the instant application obvious and as such they can not be special technical features."

Applicants traverse the rejection and submit that the Examiner's view is illogical.

First, Applicants note that the present claims do not merely recite a composition comprising olanexidine and an excipient.

Further, although "polyoxyethylene phenyl ether" is described as a surfactant in Prescriptions 1 and 2 of Ishikawa, Ishikawa nowhere describes nor suggests a "polyoxyethylene-based nonionic surfactant", which is a broader term. More specifically, Ishikawa describes a formulation comprising olanexidine and polyoxyethylene phenyl ether, but nowhere discloses a combination of olanexidine with a polyoxyethylene-based nonionic surfactant. Therefore, the composition of the present invention is clearly different from the formulation of Ishikawa.

Even further, there is no apparent reason to modify the composition taught by Ishikawa with a reasonable expectation of success in arriving at the claimed invention. That is, there is no teaching or suggestion of the claimed combination and no teaching or suggestion to modify the

composition of Ishikawa and to specifically select the polyethylene-based nonionic surfactant of formula (1) as recited in claim 1. It has been established that the prior art must suggest the desirability to modify or combine disclosures. The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). It is also insufficient to establish *prima facie* obviousness based on the assertion that a modification is within the capabilities of one of ordinary skill in the art without an objective reason to make the modification. See *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999); and MPEP § 2143.01. This is consistent with the principals of *KSR* which acknowledged the importance of identifying a reason that would have prompted a person of ordinary skill in the relevant field to combine elements *in the way the claimed invention does* in an obviousness determination (emphasis added). *KSR v. Teleflex*, 127 S.Ct. 1727, 1731 (2007). For at least this reason, the present invention is not obvious based on Ishikawa.

Moreover, the present invention provides unexpectedly superior results, which are not taught or suggested and could not have been expected from the disclosure of Ishikawa. Applicants submit a Declaration including experimental data on antibacterial activity to demonstrate that based on the above structural difference, the composition of present invention can provide unexpectedly superior results compared to the composition of Ishikawa.

The Declaration clearly demonstrates that “polyoxyethylene alkyl phenyl ether” (Example 2 of the present application) has remarkably higher levels of antibacterial activity than the “polyoxyethylene phenyl ether” of Ishikawa. Further, data on antibacterial activity in the present specification (Tables 2 and 3) show that “polyoxyethylene alkyl phenyl ether” (Example

2) and “polyoxyethylene higher alkyl ether” (Examples 3 to 5) have equally high levels of antibacterial activity. In conclusion, the “polyoxyethylene higher alkyl ether” of the present invention can provide remarkably excellent antibacterial activity compared to the “polyoxyethylene phenyl ether” of Ishikawa.

A feature of the disinfectant of the present invention is that it comprises, in addition to olanexidine, a surfactant containing a terminal alkyl group of a specific chain length (C_{7-20}) (a polyoxyethylene higher alkyl ether). Based on this structural feature, the disinfectant of the present invention exhibits extremely high levels of antibacterial activity.

Comparatively, the “polyoxyethylene phenyl ether” of Ishikawa does not contain an alkyl group having the specific carbon length. Ishikawa nowhere discloses nor suggests an alkyl group of the specific carbon length. Thus, the effect achieved by the polyoxyethylene higher alkyl ether cannot be predicted from Ishikawa. For this additional reason, the present invention is patentable over Ishikawa.

Therefore, the disinfectant of the present invention is not obvious over Ishikawa. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 103 based on Isikawa.

IV. Conclusion

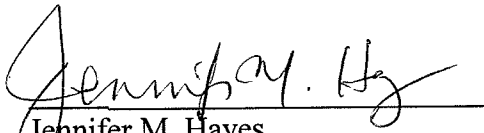
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Jennifer M. Hayes
Registration No. 40,641

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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